Remarks

The Office Action notes that claims 1-34 are pending in the application. Of these, claims 1, 11, 25, and 31 are independent. The Applicants hereby amend independent claim 25. Support for the amended claim can be found throughout the originally filed specification, claims, and drawings (e.g. Page 9, line 17 – Page 10, line 6). Therefore, no new matter has been added.

Independent claims 1, 11, and 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Will (US 6,392,640) in view of Bodnar et al. (US 6,310,634). Independent claim 25 stands rejected under 35 U.S.C. 102(b) as being anticipated by Will. The Applicants respectfully submit that the independent claims are allowable over the combination of Will in view of Bodnar et al. because the combination does not disclose all of the limitations set forth therein. Furthermore, the Office Action fails to provide sufficient motivation that would compel one of ordinary skill in the art to modify Will with the teachings of Bodnar et al.

The independent claims each include the limitation of "using a personalized and learning database." Will does not disclose a "personalized and learning database." A fact the Office Action readily concedes on page 4. Accordingly, the independent claims are allowable over Will and the rejection of claim 25 is obviated.

Nevertheless, in the rejections of claims 1, 11, and 31, the Office Action asserts that Bodnar et al. discloses a personalized and learning database and therefore "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Will with the teachings of Bodnar and include a learning database with the motivation to provide the user with a faster method of inputting." The Applicants respectfully disagree.

Modifying Will with the teachings of Bodnar would not provide the user with a faster method of inputting.

The general purpose behind Will is to improve the effectiveness of entering data on an electronic device that is too small for a keyboard, such as a device equipped with a thumbwheel. (Col. 2, lines 8-9.) Specifically, Will seeks a way of "utilizing [a] thumbwheel more effectively to enter characters." (Col. 2, lines 9-10; col. 2, lines 13-20.) Any proposed modification of Will would have to take into account (1) the lack of a keyboard, and (2) the mechanism for data entry is a thumbwheel. Attempting to modify Will to include a keyboard, or to add a mechanism for data entry other than a thumbwheel, would defeat the purpose of Will (i.e. improving the effectiveness of entering data through a thumbwheel.)

Bodnar discloses a portable computing device with a display and multiple buttons. (Figs. 3 – 5C.) The device includes the standard functions of a portable computing device (e.g. calendar, contact list, email, etc.) (Id.) A user enters most data into the device through a computer, which is kept synchronized with the device. (Col. 18, lines 38-47.) For light editing and data entry tasks, however, Bodnar et al. provide the device with a minimal input system. (Col. 18, line 47 to col. 19, line 17.) The input system appears to have some ability to "remember[ing] what the user has previously inputted" and to provide the user with "adaptive quick lists" by which the device "can anticipate what the user needs to do at any given time and can guide the user through a step-by-step process to complete each task". (Col. 19, lines 22 – 27.) The Office Action equates Bodnar et al.'s "context sensitive quick lists" and ability to remember what the user has previously inputted to the personalized and learning database of the claims. Yet, the

Office Action fails to recognize that "context sensitive quick lists" and "ability to remember" can only be used through actuating of a dedicated button (i.e. a "super-key") on the device. (Col. 19, lines 27-35.) Accordingly, adding the "context sensitive quick lists" and "ability to remember" to the Will device, would require providing the Will device with some means to actuate the "super-key" functionality.

The Office Action fails to explain how the "super-key" functionality could be added to Will. Nevertheless, assuming *arguendo* that Will and Bodnar et al. could be combined (which the Applicants do not concede as possible) two possibilities emerge. First, a dedicated button could be added to Will. Second, a soft key, actuated through the thumbwheel could be added to Will. Neither of these possibilities, however, would provide sufficient motivation for combining the references

The problem with the first possibility is that it would be inconsistent with Will's explicit purpose, i.e. utilizing a thumbwheel to more effectively add data. Such an approach would also increase the cost of manufacturing and increase the complexity of Will's device. Finally, contrary to the Examiner's assertion, the speed of inputting data would not increase because the user would have to stop entering data in order to press the "super-key" and then would have to take the time to review the "super-key" options. These additional steps would take more time, not less.

The problem with the second possibility is that, contrary to the Examiner's assertion, it would not increase the speed of inputting data. To invoke the "super-key" input, the user would have to navigate to the soft-key, press the thumbwheel and then navigate through the thumbwheel data. This would take more time, not less.

Furthermore, adding a soft key would increase the complexity of the Will's device and increase the cost of manufacturing.

In conclusion, the Applicants respectfully submit that the claims are distinguishable over Will and the combination of Will and Bodnar et al. Furthermore, claims are allowable over Will and Bodnar et al. because one of ordinary skill in the art would not combine the references. Favorable reconsideration is requested.

Respectfully Submitted

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